

ATTORNEY DOCKET NO.: 056291-5046
Application No.: 09/937,018
Page 12

REMARKS

This Substitute Amendment is being filed in response to the Advisory Action dated February 17, 2004, in which Applicant was advised that the amendment after final, filed January 20, 2004 would not be entered because "newly added claims 17-19 are different in scope as compared to previously pending claim 13 and therefore, require additional consideration and/or search." It is understood that all other aspects of the January 20, 2004 amendment were directly responsive to remaining grounds for rejection stated in the Final Rejection, or otherwise placed the claims in condition for allowance and/or were acceptable to the Examiner. Accordingly, the Substitute Amendment is being presented, in substitution for the non-entered January 20, 2004 amendment, in which the same amendments and remarks are being presented except that new claims 17-19 are now omitted. The cancellation of claim 13 without replacement herein is being made in order to expedite the prosecution of this application to allowance, and is without prejudice to Applicant's right to prosecute the omitted subject matter in one or more continuing applications.

The following remarks are identical to the remarks presented with the January 20, 2004 Amendment, except that reference to claims 17-19 has been omitted:

Claims 1 and 13 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the canceled subject matter in a divisional application. Claim 2 has been rewritten in independent form and incorporates all of the limitations of canceled claim 1. In addition, claim 2 has been amended to correct a typographical error; namely, the replacement of "piperidino" with "piperidinyl." Support for this particular amendment may be found in Applicant's specification at, for example, page 15, line 1. The amendments to claims 3-10 and

ATTORNEY DOCKET NO.: 056291-5046
Application No.: 09/937,018
Page 13

12 remove these claims' dependencies on canceled claim 1 and delete the presence of any repetitious claim language resulting from the rewriting of claim 2 in independent form.

New method claims 14-16 have been added. Claims 14 and 15 recite methods for producing a p38 kinase and TNF α inhibitory effect, respectively, by the administration of a compound of Formula (I), while claim 16 recites a method for the treatment of rheumatoid arthritis by the administration of a compound of Formula (I). Support for claims 14-16 can be found in Applicants' specification at, for example, page 2, lines 18-20; page 35, line 17 to page 36, line 29; page 37, line 2 to page 39, line 12; and page 39, lines 14-30. No new matter has been introduced by any of the amendments. After entry of the above amendments, claims 2-10, 12 and 14-16 will be pending.

Allowable Subject Matter

The Examiner has indicated that claims 2-8 would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. For the record, Applicants disagree with the Examiner's continued rejection of (a) claim 13 under 35 U.S.C. § 102(b) as anticipated by *Thompson*; (b) claims 1, 9-10 and 12 under 35 U.S.C. § 103(a) as unpatentable over *Ugarkar*; and (c) claims 1, 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over *Wiesenfeldt*. However, in an effort to expedite prosecution of this application, Applicants have canceled claims 1 and 13, rewritten claim 2 into independent form, and amended claims 3-10 and 12 such that they depend from amended claim 2. As such, Applicants believe that claims 2-10 and 12 are in condition for allowance. New dependent method claims 14-16 are also limited to the scope of claim 2 and find full support in Applicants' specification.

ATTORNEY DOCKET NO.: 056291-5046

Application No.: 09/937,018

Page 14

Conclusion

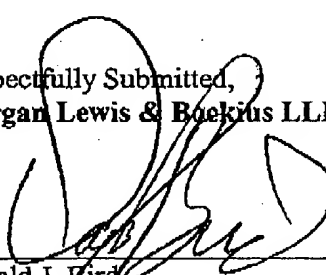
In an effort to expedite prosecution of this application to allowance, the claims have been amended, without prejudice, to obviate the anticipation and obviousness grounds for rejection. In view of these amendments and the foregoing remarks, it is believed that this application is in condition for allowance. Accordingly, entry of the foregoing amendments and allowance of all claims are believed to be in order, and are respectfully requested.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,
Morgan Lewis & Bockius LLP

Date: February 24, 2004
Morgan Lewis & Bockius LLP
Customer No. 009629
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel. No.: 202-739-3000
DJB:

By:



Donald J. Bird
Registration No. 25,323
Tel. No.: (202) 739-5320
Fax No.: (202) 739-3001